REMARKS

Claims 1-40 were pending prior to filing this Response. Claims 1-15 are being amended herein. Claims 16-39 are being canceled. Claims 41 and 42 are being added. Therefore claims 1-15, 41 and 42 remain for consideration.

Claims 14, 25 and 37 are objected to for minor informalities. Claims 25 and 37 are being canceled herein and therefore no longer remain for consideration. Claim 14 is amended herein in order to specifically address the informalities. Accordingly, it is respectfully submitted that the objection to the claims is overcome.

Claims 7, 16, 18, 39 and 40 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. The rejection is traversed and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

Claims 16, 18, 39 and 40 are being canceled herein and therefore no longer remain for consideration. Claim 7 and independent claim 1 are being amended herein in order to more clearly define the sheath as part of the housing. It is therefore respectfully submitted that the rejection of claim 7 is overcome.

Claims 16-39 are rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1-15 of the present application. Claims 16-39 are being canceled herein. It is therefore respectfully submitted that the § 101 rejection of claims 16-39 is now moot.

Claims 1-7, 10-12, 16-18, 21-23, 27-29, 32-35, 39 and 40 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Rogers, Jr. (U.S. Publ. No. 2004/0188302). The rejection is traversed and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

Rogers, Jr. is directed to a packaging device and method which can include an inflatable pouch into which a medical device or other bio-hazardous or dangerous device can be contained and eventually shipped. Caps can be provided and placed over sharp parts or other parts of the medical device that may puncture the

inflatable pouch or may need added protection. Primary and secondary pouches can also be provided into which the device can be placed before it is sealed into the inflatable pouch. A box, suitcase or other carrying structure can be provided, and the inflatable pouch containing the medical device can be placed into the carrying structure for shipment. In addition, a second inflatable pouch can be provided in an uninflated state such that the receiver of the shipment can return the device in the second inflatable pouch.

Rogers, Jr. does not teach or suggest a sterile apparatus to protect endoscope(s) comprising an impact resistant housing having an outer surface defining an opening, an interior of the housing defining a canal having a first end communicating with the opening and a second end terminating within the housing for receiving a distal lens of an endoscope, and a defogging material disposed adjacent to the second end of the canal for defogging a distal lens of an endoscope when inserted within the canal, as is recited in amended claim 1 of the present application.

It is not surprising that Roger, Jr. does not teach or suggest a sterile apparatus including a canal and defogging material disposed therein. The claimed sterile apparatus is configured to protect an endoscope and to prevent fogging of a distal lens of the endoscope during a surgical procedure. The packaging device of Rogers, Jr., on the other hand, is used for safely and economically transporting bio-hazardous equipment through courier or mail services for cleaning, maintenance, disposal or other event. (See paragraph [0003] of Rogers, Jr.). Rogers, Jr. is silent on using its packaging device for protecting and defogging a distal lens of an endoscope or any other device during a surgical procedure.

For an anticipation rejection to be appropriate, each and every element or limitation in a rejected claim must be shown in a single prior art reference used in the claim rejection. Because Rogers, Jr. does not teach or suggest a sterile apparatus comprising an impact resistant housing having an outer surface defining an opening, a canal and a defogging material disposed therein, as is recited in amended

claim 1 of the present application, it cannot be maintained that Rogers, Jr. anticipates claim 1. Moreover, because remaining rejected claims 2-7 and 10-12 each ultimately depend from and thereby incorporate the limitations of claim 1, these dependent claims are not anticipated by Rogers, Jr. for at least the reasons set forth for claim 1.

Claims 13-15, 24-26 and 36-38 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rogers, Jr. (U.S. Publ. No. 2004/0188302). The rejection is traversed and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

The Examiner states that Rogers, Jr. teaches a handle on a case for transportation. The Examiner believes that it would have been obvious to use an allegedly equivalent structure such as the claimed anchor and cord. Applicant respectfully disagrees with the Examiner. The claimed anchor and cord is not the equivalent of a transportation handle on a carrying case. The claimed anchor and cord is not for transportation, but rather for securing the apparatus to a surface so that the apparatus is not moved or otherwise lost during a surgical procedure. Since the case of Rogers et al. is used for transportation of bio-hazardous products and is not concerned with securing the case to a surface, it would make no sense and would therefore not have been obvious to use a cord and an anchor with the case of Rogers et al.

Moreover, remaining rejected claims 13-15 each ultimately depend from and thereby incorporate the limitations of claim 1. As was demonstrated above, claim 1 is not anticipated by Rogers et al. It therefore follows that Rogers, et al. contains insufficient teaching even when modified with an anchor and cord to render claims 13-15 obvious.

Claims 8, 19 and 30 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rogers, Jr. (U.S. Publ. No. 2004/0188302) in view of Dohm et al. (U.S. Pat. No. 5,720,391). The rejection is traversed and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

Dohm et al. is directed to packaging and a holder provided for a heart valve prosthesis. The holder is adapted to grasp the heart valve prosthesis and includes a post. The packaging includes a collar for holding the post of the holder. An inner tray of the packaging receives the collar such that the prosthesis is suspended within the inner tray. An outer tray receives the inner tray. An inner tray lid seals the inner tray and an outer tray lid seals the outer tray.

The Examiner apparently cites Dohm et al. for mentioning that Styrofoam can be used for a transportation case for medical instruments. Remaining rejected claim 8 depends from and thereby incorporates the limitations of claim 1. It has been demonstrated above that Rogers et al. contains insufficient teaching to anticipate claim 1. It therefore follows that Rogers et al. also contains insufficient teaching when taken either alone or in combination with Dohm et al. to render claim 8 obvious.

Claims 9, 20 and 31 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rogers, Jr. (U.S. Publ. No. 2004/0188302) in view of Lantz (U.S. Pat. No. 6,910,582). The rejection is traversed and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

Lantz is directed to a shock absorbing insulated shipping container including an external corrugated cardboard box, receiving an insulated body having a cavity for holding breakable glass bottles. The bottles may contain a high value liquid product being shipped, such as medicine or wine. The container also receives an especially configured and constructed, shock-absorbing filling structure or partition system for separating the glass bottles from one another, and from one or more receptacle cavities for holding phase change coolant or temperature control material in a predetermined relationship to the glass bottles. The container also includes an insulating and cushioning cover adapted to engage into a top opening of the insulated body after the bottles and coolant are received in the cavity thereof. The insulated body is formed from injection molded polyurethane, wrapped in a plastic film.

The Examiner apparently cites Lantz for mentioning that gel can be used for a transportation case for cushioning. Remaining rejected claim 9 depends from and thereby incorporates the limitations of claim 1. It has been demonstrated above that Rogers et al. contains insufficient teaching to anticipate claim 1. It therefore follows that Rogers et al. also contains insufficient teaching when taken either alone or in combination with Lantz to render claim 9 obvious.

In view of the foregoing, it is respectfully submitted that claims 1-15, 41 and 42 are in condition for allowance. All issues raised by the Examiner having been addressed, an early action to that effect is earnestly solicited.

Applicant hereby petitions for a one-month extension of time to file this Response. A check in the amount of $60.00 is enclosed for covering the extension fee for a small entity. No additional fees or deficiencies in fees are believed to be owed. However, authorization is hereby given to charge our Deposit Account No. 13-0235 in the event any such fees are owed.

Respectfully submitted,

By Daniel G. Mackas

Daniel G. Mackas
Registration No. 38,541
Attorney for Applicant

McCORMICK, PAULDING & HUBER LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-3410
(860) 549-5290